

### REMARKS

Claims 15-26 and 31-48 are pending in the application. The Examiner is respectfully requested to reconsider and withdraw the rejections in view of the amendments and remarks herein.

#### *Claim Rejections – 35 U.S.C. § 101*

The rejection of claims 15-26 and 31-40 under 35 U.S.C. § 101, has been maintained. This rejection is respectfully traversed.

Claim 15 has been amended herein to include a data processing apparatus and a computer readable storage medium. Consequently, claim 15, as well as each of claims 16-26 which ultimately depend therefrom, includes statutory structure. Therefore, reconsideration and withdrawal of the rejection are respectfully requested.

Claim 31 has been amended to include storing a configurable task set in a computer readable storage medium, and reading the configurable task set from the computer readable storage medium. Consequently, claim 31, as well as claims 32-40 which ultimately depend therefrom, are tied to a statutory class. Therefore, reconsideration and withdrawal of the rejection are respectfully requested.

#### *Claim Rejections – 35 U.S.C. § 112*

The rejection of claim 15 under 35 U.S.C. § 112, second paragraph, has been maintained. This rejection is respectfully traversed.

As discussed above, claim 15 has been amended to include a data processing apparatus and a computer readable storage medium. Consequently, claim 15 makes clear “what hardware the software portion of the claim operates on,” as required by the Examiner (see instant Office action at Page 3). Therefore, reconsideration and withdrawal of the rejection are respectfully requested.

Claims 15-26 and 31-48 stand rejected under 35 U.S.C. § 112, first paragraph. This rejection is respectfully traversed.

In rejecting claims 15-26 and 31-48, the Examiner has asserted that, “while being enabled for simplification by redundancy or transivity, [the rejected claims do] not reasonably provide for

all other methods of simplification.” (see instant Office action as Page 3). In other words, the Examiner has asserted that the feature of simplifying a specification of the constraints is too broad, because every possible form of simplification is not specifically addressed in the description.

At the outset, Applicants respectfully note that the standard for determining whether the specification meets the enablement requirement is whether the experimentation needed to practice the invention is undue or unreasonable (see MPEP § 2164.01, citing *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916)), which is still the standard to be applied (*Id.*, citing *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988)). In assessing enablement, MPEP § 2164.01(a) lists at least eight factors that must be considered, with claim breadth being only one of the factors, and provides that it “is improper to conclude that a disclosure is not enabling based on an analysis of only one of the above factors while ignoring one or more of the others. The examiner’s analysis must consider all the evidence related to each of these factors, and any conclusion of nonenablement must be based on the evidence as a whole.” (see MPEP § 2164.01(a), citing *In re Wands*, 858 F.2d at 737, 740, 8 USPQ2d at 1404, 1407). As discussed in further detail below, the Examiner failed to apply the appropriate enablement standard, and only considered one factor in assessing enablement.

As noted above, the test for enablement is whether undue or unreasonable experimentation is required to practice the invention. In making the instant rejection, however, the Examiner has only asserted that the specification does not enable every possible form of simplification (see instant Office action at Page 4). Consequently, the Examiner has failed to address the appropriate standard of whether undue or unreasonable experimentation is required to practice the invention.

Applicant’s respectfully note that undue or unreasonable experimentation is indeed not required to practice the instant invention. More specifically, the instant application enables one skilled in the pertinent art to simplify a specification of the constraints, as provided in each of independent claims 15, 31 and 41. Exemplar manners, in which a specification of the constraints can be simplified, are provided at page 3, ll. 15-19, page 12, ll. 12-16 of the specification, as originally filed. Consequently, one skilled in the pertinent art is able to practice the instant

invention without undue or unreasonable experimentation. Therefore, the feature of simplifying a specification of the constraints is enabled.

Furthermore, the Examiner has only considered one factor in assessing enablement. More specifically, the Examiner has only considered the breadth of the subject claim feature, while ignoring the other factors. Consequently, the Examiner has failed to consider all the evidence related to each of the factors, and has failed to base the instant rejection on the evidence as a whole.

As a further note, it is not necessary that the specification "describe how to make and use every possible variant of the claimed invention, for the artisan's knowledge of the prior art and routine experimentation can often fill gaps, interpolate between embodiments, and perhaps even extrapolate beyond the disclosed embodiments, depending upon the predictability of the art." (see *Genentech, Inc. v. Novo Nordisk A/S*, 108 F.3d 1361, 1366 (Fed.Cir.1997)). In fact, "[a] patent need not teach, and preferably omits, what is well known in the art." (see MPEP § 2164.01, citing *In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991)).

In view of the foregoing, reconsideration and withdrawal of the rejection are respectfully requested.

#### Claim Rejections – 35 U.S.C. § 103

Claims 15-26 and 31-48 stand rejected under 35 U.S.C. § 103(a) as being obvious over Shazia Sadiq et al., "Pockets of Flexibility in Workflow Specification," *Proceedings of the 20<sup>th</sup> International Conference on Conceptual Modeling, Lecture Notes In Computer Science*, 2224, pp. 513-526 (H.S. Kunii, et al.) in view of Official Notice. This rejection is respectfully traversed.

As discussed in Applicants' previous response, each of the independent claims recite simplification of a specification of the constraints, and this feature is not disclosed or rendered obvious by Sadiq. In fact, the Examiner has noted that Sadiq indeed fails to disclose simplification of a specification of constraints (see instant Office action at page 5). In view of the deficient disclosure of Sadiq, the Examiner relies on Official Notice to substantiate the rejection.

As provided for in MPEP § 2144.03, Official Notice unsupported by documentary evidence should only be taken by the Examiner "where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known." More specifically, the notice of facts beyond the record which may be taken by the Examiner must be "capable of such instant and unquestionable demonstration as to defy dispute" (see *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)). Further, the Examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support the conclusion of common knowledge (see *In re Soli*, 317 F.2d at 946, 37 USPQ at 801; *In re Chevenard*, 139 F.2d at 713, 60 USPQ at 241). Applicants respectfully note that the facts asserted to be well-known in the instant rejection are not capable of such instant and unquestionable demonstration as to defy dispute, and that the Examiner has not provided specific factual findings predicated on sound technical and scientific reasoning to support the conclusion of common knowledge.

In taking Official Notice, the Examiner has asserted that "it is old and well known to simplify a specification of the constraints" (see instant Office action at Page 5). As an example, the Examiner states that "redundant constraints are removed from workflows to reduce unnecessary processing demands" (see *Id.*). The Examiner's assertions, however, lack the requisite specific factual findings predicated on sound technical and scientific reasoning. Instead, the Examiner has only recited the claim feature and asserted that is well known. Further, the Examiner has taken the subject claim feature out of context. More specifically, the subject specification of constraints is in the context of constraints that define relationships between tasks. The Examiner's example in support of the Official Notice, however, is directed toward removing redundant workflow constraints, and does not address specifications of constraints that define relationships between tasks.

For at least the foregoing reasons, the Official Notice set forth in the instant rejection is improper. Therefore reconsideration and withdrawal of the rejections are respectfully requested.

In view of the foregoing, Sadiq does not teach all of the features of independent claims 15, 31, or 41 or their dependent claims. Accordingly, Applicants respectfully request that this rejection be withdrawn.

Applicant : Sadiq et al.  
Serial No. : 10/671,876  
Filed : September 29, 2003  
Page : 11 of 12

Attorney's Docket No.: 13909-0115001 / 2003P00187  
US02

Each of claims 16-26, 32-40 and 42-48 ultimately depends from one of claims 15, 31 and 41, which define over the asserted reference, as discussed in detail above. Consequently, each of claims 16-26, 32-40 and 42-48 also defines over the asserted reference for at least the same reasons. Therefore, reconsideration and withdrawal of the rejections are respectfully requested.

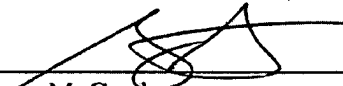
CONCLUSION

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reason for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to amendment. Applicants respectfully request consideration of all filed IDS' not previously considered, by initialing and returning each Form 1449.

No charges are believed due. However, if any fees are due, they are being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account authorization. Please apply all charges or credits to Deposit Account No. 06-1050, referencing Attorney Docket No. 13909-0115001.

Respectfully submitted,

Date: February 23, 2009

  
\_\_\_\_\_  
Ryan McCarthy  
Reg. No. 50,636

**Customer No. 32864**  
Fish & Richardson P.C.  
Telephone: (512) 472-5070  
Facsimile: (877) 769-7945